

REMARKS

A STATEMENT OF STATUS OF CLAIMS AND SUPPORT FOR CLAIM CHANGES 37 CFR 1.173(c) is ATTACHMENT 1 herewith. In addition to the discussion of support for claim changes referred to in the preceding sentence, the specific objections and rejections set forth in the November 27, 2001 Office Action (hereinafter "OA") are responded to.

OA, page 1, second paragraph: The Examiner is thanked for pointing out the subject matter which should be deleted from previously amended claims 1, 31, and 35. Claim 1 has been cancelled and claims 31 and 35 amended as suggested by the Examiner.

OA, page 1, third paragraph: The newly added claims 44-79 in the September 19, 2001 Amendment have been resubmitted and are entirely underlined.

OA, page 1, last paragraph: The Examiner is thanked for noting that "Rejections and objections made in the previous Office Action that does not appear below have been overcome."

OA, page 2, first paragraph: The objection was to claim 11 which is cancelled in the present Amendment.

OA, pages 2 and 3, the last complete paragraph on page 2 and the paragraph bridging pages 2 and 3: The rejections set forth in these paragraphs are responded to in the discussion hereinafter and in ATTACHMENT I herewith.

Claims 1 and 6-12 are cancelled by the present amendment. (Claims 2-5 were cancelled in the Amendment filed September 19, 2001). The cancellation of claims 1 and 6-12 is not meant to be considered an agreement that the 35 USC 112 and 251 rejections directed to said claims are rejections which could not have been successfully traversed. These claims (1 and 6-12) are cancelled to narrow issues and expedite the prosecution.

Method claims 31 and 35, each of which depended from claim 1 for identification of the compounds, have been rewritten herein as independent claims without changing the scope of the definition of the compounds as set forth in said Amendment filed September 19, 2001 (except for the deletion suggested by the Examiner which is referred to in the second paragraph of these REMARKS). Method claims 31-38 as presented in the reissue application including the Preliminary Amendment were not rejected over the prior art in the Office Action of April 20, 2001. The benefit of applicants' Japanese priority application is not claimed for claims 31-38. Claims 31, 32, 35 and 36 from which subject matter was deleted by the Preliminary Amendment have not been further amended to delete subject matter to obtain the

benefit of the priority of the Japanese application. All of the other amended claims (except for the species claims) have been amended by deleting subject matter (i.e., identified groups) from the definitions of  $R^1$  and  $R^2$  and by narrowing some, but not all, carbon atom ranges in the definition of  $R^4$ .

The definition of the compounds as set forth in claim 1 amended September 19, 2001 included deletion of the originally recited  $R^1$  substituent  $-NHR^a$  (deleted by the Preliminary Amendment) which resulted in  $R^1$  being directed to an alkyl group having from 1 to 6 carbon atoms or an amino group. Claim 1 (and claims 5 and 6 which were amended by the Preliminary Amendment to delete "an acetylamino group" (a species of  $-NHR^a$ ) from the definition of  $R^1$ , were not objected to or rejected in the first Office Action (April 20, 2001) based on the preliminary amendments of the definition of  $R^1$  discussed in the preceding sentence. Aside from the amendment to the definition of  $R^1$  discussed in the preceding sentences of this paragraph, the presently amended compound claims 13, 14 and 15 (and the generally corresponding method claims depending from independent method claims 28 and 40) have few deletions and/or additions to the patent claims.

OA, page 3, the complete paragraph: Support in the specification or the originally filed claims for the genus where R is hydrogen only and where  $R^1$  is methyl or amino only, is

questioned. The definition of R as hydrogen only is supported by the disclosure in column 4, lines 47-48; original claims 4 and 15; and column 14, lines 36-39 which disclose "The most preferred classes of compounds of the present invention are those in which: (K) R represents a hydrogen atom." Original claim 5 depended from claim 1 and defined R<sup>1</sup> as a methyl group, an amino group or an acetylamino group and original claim 6, which also depended from claim 1, defined R<sup>1</sup> as an amino group or an acetylamino group. Patent claim 13 defines R<sup>1</sup> as a methyl group, an amino group or an acetylamino group. Patent claims 14 and 15 defined R<sup>1</sup> as an amino group or an acetylamino group and patent claim 15 defined R as hydrogen only. Claims 13, 14 and 15 were amended by Preliminary Amendment to delete "acetylamino" which is a species of the group -NHR<sup>a</sup> in claim 1 (which group was also deleted by Preliminary Amendment) and these deletions were not the subject of any objection or rejection in the first Office Action of April 20, 2001. The legal discussion hereinafter points out that applicants have the right to claim less than all of their originally claimed invention without violating the written description requirement of 35 USC 112, first paragraph.

With the exception of the deletion by Preliminary Amendment of the subject matter from the definition of R<sup>1</sup> discussed in the preceding sentences, and subsequent limiting of R to "hydrogen" and the deletion of "a mercapto group" and of "an alkanoylthio group having from 1 to 4 carbon atoms" from the definition of R<sup>2</sup>

and narrowing of several carbon ranges, the amended claims 13, 14 and 15 correspond to original patent claims 13, 14 and 15 and also to the corresponding disclosure in columns 12-14. The amendments to claims 13, 14 and 15 discussed in the preceding sentence which were presented in the Amendment filed September 19, 2001 and carried into the presently amended claims were made to conform the scope of these claims to the disclosure of the Japanese priority application. Stated differently, the September 19, 2001 amendments were made so that the amended claims would be entitled to the benefit of the April 5, 1996 filing date of the priority application JP 8-083562. Claim 13 is supported by the disclosure of preferred classes of compounds in column 12, line 56 through column 13, line 44. Claim 14 is supported by the disclosure of preferred classes of compounds starting in column 13, line 49 through column 14, line 35. Claim 15 (wherein R was originally limited to hydrogen) is supported by the disclosure of most preferred classes of compounds, column 14, lines 36-43. The embodiment of the compounds wherein R<sup>1</sup> is amino is further supported by the presence of this group in 24 of the 27 compounds of the invention which the specification discloses to be preferred (see column 26, line 61 through column 27, line 40).

OA, page 3: The last sentence of the complete paragraph notes "There does appear to be support in the originally filed specification and claims for changing the carbon ranges in the

alkyl, alkoxy, alkylenedioxy, aryl and/or alkylthio groups defined for either  $R^3$ ,  $R^4$ ,  $\alpha$  or  $\beta$ ." Presently amended claims 13, 14 and 15 do not include any amendments in the definition of  $R^3$ .  $R^4$  recites a change in the carbon atom length of the originally claimed range of 1 to 6 carbon atoms to the presently recited range of 1 to 4 carbon atoms. These  $C_1$ - $C_4$  ranges are supported by disclosure in column 7, lines 36-49 and lines 63-64; and in column 12, lines 18-19.

OA, the paragraph bridging pages 3 and 4: The claims are rejected under 35 USC 251 as being based upon new matter added to the patent; specifically the subject matter rejected as "new matter" is the cycloalkyl group having from 3 to 7 carbon atoms and the cycloalkyloxy group having from 3 to 7 carbon atoms (each in the definition of  $R^4$ ). Claims 13, 14 and 15 as they appear in the patent and as presently amended, in the definition of  $R^4$ , define the cycloalkyl group as having from 3 to 6 carbon atoms. Accordingly, the cycloalkyl group rejection is not applicable against any of the present claims. The presently amended claims 13, 14 and 15 (and the corresponding method claims) define the cycloalkyloxy group as having from 3 to 7 carbon atoms, whereas the patent claims 13, 14 and 15 recite a cycloalkyloxy group of from 3 to 8 carbon atoms. The 3-7 carbon atom length for the cycloalkoxy group is supported by column 9, line 14-20 and further supported by the following disclosure in column 12, lines 28-29:

"...and cycloalkyloxy groups having from 3 to 8 carbon atoms, such as the cyclopropyloxy, cyclobutyloxy, cyclopentyloxy, cyclohexyloxy and cycloheptyloxy groups."

It is respectfully submitted that the decisions in In re Johnson and Farnham, 194 USPQ 187 (CCPA 1977) and in In re Driscoll, 195 USPQ 434 (CCPA 1977) are binding precedent relative to the 35 USC 112 written description issues in the present reissue application. In each of these cases, an initially broader claim was narrowed by deleting part of the originally claimed subject matter to avoid prior art or a prior invention (lost counts in an interference). Narrowing of a Markush claim was central to the issue in In re Johnson and Farnham. The amount of subject matter deleted relative to the original subject matter in the facts of each of these two cases was greater than the amount of subject matter deleted from applicants' patent claims.

The court in In re Johnson and Farnham, at page 196, stated

"[10] The notion that one who fully discloses, and teaches those skilled in the art how to make and use, a genus and numerous species therewithin, has somehow failed to disclose, and teach those skilled in the art how to make and use, that genus minus two of those species, and has thus failed to satisfy the requirements of §112, first paragraph, appears to result from a hypertechnical application of legalistic prose relating to that provision of the statute. All that happened here is that appellants narrowed their claims to avoid having them read on a lost interference count.

"[11] The board indicated that 'it is manifestly immaterial' why appellants limited their claims. Though it is true that insufficiency under §112 could not be cured by citing the causes for such insufficiency, it is not true that the factual context out of which the question under §112 arises is immaterial. Quite the contrary. Here, as we hold on the facts of this case, the 'written description' in the 1963 specification supported the claims in the absence of the limitation, and that specification, having described the whole, necessarily described the part remaining. The facts of the prosecution are properly presented and relied on, under these circumstances, to indicate that appellants are merely excising the invention of another, to which they are not entitled, and are not creating an 'artificial subgenus' or claiming 'new matter.'

"In summary, and for the reasons discussed, the rejections of claims 64 and 68-72 under §112, first and second paragraphs, are reversed; appellants' 1963 disclosure satisfied §112, first paragraph, with respect to claims 1-9, 64, and 68-70 and appellants are, therefore, entitled to the benefit of their 1963 filing date under 35 USC 120. The Netherlands patent is thus rendered unavailable as a prior art reference, and the rejection of the claims under 35 USC 102 or 103 is reversed."

The court in In re Driscoll at page 438 stated

"This record presents yet another instance of the sort of 'hypertechnical application' of the written description requirement of §112 which was recently criticized in In re Johnson, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977).<sup>8</sup> Were the board's decision permitted to stand, future applicants, particularly in cases of this nature, would in all likelihood find themselves in the predicament reflected in the following observation, by Judge Learned Hand:

"If, when [applicants] yield any part of what they originally believed to be their due, they substitute a new 'invention,' only two courses will be open to them: they must at the outset either prophetically divine what the art contains, or they must lay down a barrage of claims, starting with the widest and proceeding by the successive



incorporation of more and more detail, until all combinations have been exhausted which can by any possibility succeed. The first is an impossible task; the second is a custom already more honored in the breach than in the observance, and its extension would only increase that surfeit of verbiage which has for long been the curse of patent practice, and has done much to discredit it. *It is impossible to imagine any public purpose which it could serve.* [Emphasis added.]"

In Fujikawa v. Wattanasin, 39 USPQ2d, 1895 (Fed. Cir. 1996), the court affirmed the Board's denial of Fujikawa's motion to add a sub-genus count to the interference because it found that Wattanasin's disclosure did not sufficiently describe Fujikawa's proposed count. Fujikawa's proposed count would have deleted a larger portion of Wattanasin's disclosed compounds than the portion of applicants' originally claimed compounds which is deleted in the presently amended claims. As to claims 80-86 which are directed to subject matter disclosed to be preferred, the present situation is further distinguished from the Fujikawa v. Wattanasin fact situation in which the proposed count was directed to subject matter which Wattansin did not disclose to be preferred. It is respectfully submitted that applicants' fact situation falls squarely within the In re Johnson and Farnham and In re Driscoll holdings and clearly outside of the Fujikawa v. Wattanasin holding.

Applicants rely upon the decisions in In re Wertheim, 191 USPQ 90 (CCPA 1976) and Union Oil of Cal. v. Atlantic Richfield

Co., 54 USPQ2d 1227 (Fed. Cir. 2000) to support applicants' position that the narrowed carbon ranges set forth in applicants' amended claims are supported by the original patent disclosure and claims to comply with the written description requirements of 35 USC 112, first paragraph.

It is respectfully submitted that the original specification and original claims fully meet the 35 USC 112, first paragraph written description requirement.

OA, page 4, first complete paragraph: The original patent or a Declaration as to loss or inaccessibility of the original patent, will be filed to meet the requirements of 37 CFR 1.178.

OA, page 4, second complete paragraph: A Supplemental Reissue Declaration will be filed shortly.

OA, paragraph bridging pages 4 and 5: Species claims 16-24 were noted as being allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Each of claims 16-24 has been rewritten in independent form and, accordingly, should be allowed.

Species claims 44-52 correspond to claims 16-24, respectively, except that claims 44-52 depend from method claim 28. Similarly, species claims 53-61 specify the same

species but depend from method claim 31. Claims 62-70 specify the same species but depend from method claim 35. Claims 71-79 specify the same species but depend from method claim 40. It is respectfully submitted that method claims 44-79, each of which specifies a compound of allowable claims 16-24, are also allowable.

OA, page 5, first complete paragraph: The present amendment responds to the two substantive grounds of rejection set forth in the Office Action of November 27, 2001, namely the rejection under 35 USC 112 and the rejection under 35 USC 251. If the Examiner does not hold that all of the claims are allowable, the Examiner is requested to telephone the undersigned attorney who will attempt to resolve objections and expedite a holding that the presently claimed subject matter is allowable. If one or more rejections are maintained, entry of the present amendment is solicited because it will substantially narrow issues on appeal.

It is considered that there is an interference situation between (i) claims in USP 5,908,858 and claims in this application for reissue of USP 5,908,858 and (ii) claims in the Khanna et al USP 5,935,990 which was relied upon in the Office Action of April 20, 2001 for rejection of claims under 35 USC 102 and/or 35 USC 103.

Allowance of the pending claims is solicited.

Please apply the enclosed check in the amount of \$924.00 as the additional filing fee required by the present amendment (see the enclosed PTO Form PTO/SB/56 entitled REISSUE APPLICATION FEE TRANSMITTAL FORM).

Respectfully submitted,

  
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Enclosures:

ATTACHMENT 1  
REISSUE APPLICATION FEE TRANSMITTAL FORM (Form PTO/SB/56)  
Check No. 84881 for \$924.00

ATTACHMENT 1

Attorney Docket No. 970113R/HG

**IN THE UNITED STATES PATENT  
AND TRADEMARK OFFICE**

First named  
Applicant : Kimura  
Serial No. : 09/678,218  
Filed : September 29, 2000  
Art Unit : 1626  
Examiner : L. Stockton

**STATEMENT OF STATUS OF CLAIMS AND  
SUPPORT FOR CLAIM CHANGES 37 CFR 1.173(c)**

Assistant Commissioner for Patents

S I R :

This statement provides "...an explanation of the support in the disclosure in the patent for the changes made to the claims". The subject matter of pages 42-46 of the Amendment to which this paper is an attachment provides an explanation of the sequential amendments and explains the reasons for said amendments and identifies support in the specification for said amendments.

The Preliminary Amendment filed with the reissue application deleted the "acetylamino" group from the definition of R<sup>1</sup>. The Amendment filed September 19, 2001 then amended all of the claims (except for the species claims which did not require such amendment and except for claims 30-38) to remove a portion of the

originally claimed subject matter which is not supported in the disclosure of applicants' priority application JP 8-083562 thereby entitling all of the amended claims to the benefit of the Japanese priority date of April 5, 1996. The original species claims are carried forward without any changes, except for a change of claims 16-24 from dependent to independent form. (The benefit of the priority date is not claimed for the subject matter of claims 31-37 and these claims were not amended by deleting the subject matter referred to in the preceding sentences.) Specifically, the subject matter deleted from the claims to obtain the benefit of said Japanese priority date is the limitation of R to be hydrogen, the deletion of acetylamino from R<sup>1</sup> and the deletion of a mercapto group and of an alkanoylthio group from the definition of R<sup>2</sup>. Additionally, carbon atom ranges in the definition of R<sup>4</sup> were narrowed to C<sub>1</sub>-C<sub>4</sub> from C<sub>1</sub>-C<sub>6</sub> and to cycloalkyloxy of 3 to 7 carbon atoms from the original 3 to 8 carbon atoms. Support for the present claims is explained in detail on pages 43-47 of the Amendment to which this paper is attached which is hereby incorporated herein. The discussion in this paragraph explains the support for the subject matter which was deleted and for the subject matter which was added and applies to all of the claims with the exception of the species claims and with the exception of pending claims 31-37 for which the priority of the Japanese application is not claimed.

Claim 1 (cancelled).

Claim 2 (cancelled).

Claim 3 (cancelled).

Claim 4 (cancelled).

Claim 5 (cancelled).

Claim 6 (cancelled).

Claim 7 (cancelled).

Claim 8 (cancelled).

Claim 9 (cancelled).

Claim 10 (cancelled).

Claim 11 (cancelled).

Claim 12 (cancelled).

Claim 13 (pending): Claim 13 corresponds to the preferred classes of compounds disclosed in column 12, line 57 through column 13, line 48, with deletions and additions as discussed below. Earlier, R was limited to hydrogen, R<sup>1</sup> was amended to delete "or an acetylamino group", and R<sup>2</sup> was amended to delete "a mercapto group; an alkanoyl group having from 1 to 4 carbon atoms" (the deleted "alkanoyl" should have been "alkanoylthio" as in the corresponding definition in the specification and the other original patent claims). The definition of R<sup>4</sup> was revised by narrowing certain of the carbon atom ranges. Support for all of said changes is discussed in the REMARKS of the present Amendment, pages 42-46.

In the present amendment claim 13 was amended into independent form. In the definition of R<sup>2</sup>, "haloalkyl" was changed to "haloalkoxy" which corrects an error in patent claim 13 (see support in column 13, line 11.) The definition of R<sup>4</sup> has been amended by inserting "a hydroxy group," which was inadvertently omitted in the patent (see column 13, line 43 which refers to substituents  $\alpha$  which are defined in column 3, lines 59-62).

Claim 14 (pending): Claim 14 corresponds to the preferred classes of compounds disclosed in column 13, line 49 through column 14, line 35, with deletions and additions as discussed below. The earlier deletions from the definitions of R, R<sup>1</sup> and R<sup>2</sup> are the



same as in claim 13. R is limited to hydrogen. The September 19, 2001 Amendment deleted all of the subject matter from the definition of R<sup>3</sup> except "an alkyl group having from 1 to 4 carbon atoms" and deleted all of the subject matter from the definition of R<sup>4</sup> except hydrogen. These R<sup>3</sup> and R<sup>4</sup> amendments were an error based on a reversal of substituents; the preferred R<sup>3</sup> is hydrogen and a preferred R<sup>4</sup> is an alkyl group having from 1 to 4 carbon atoms. The present amendment restores the definitions of R<sup>3</sup> and R<sup>4</sup> to the definitions as they appear in the patent claim, except for the narrowing of carbon atom ranges in R<sup>4</sup> which has the same support in the original specification as discussed for claim 13. The present amendment removes the feature that the compound is of the formula (II) which appeared on line 2 of the claim as amended September 19, 2001.

Claim 15 (pending): Claim 15 corresponds to the preferred classes of compounds disclosed in column 14, lines 36-43, with deletions and additions as discussed below. The earlier deletions to the definitions of R<sup>1</sup> and R<sup>2</sup> are the same as in claims 13 and 14 with the same support. The September 19, 2001 Amendment defined R<sup>3</sup> as a "methyl group" only and deleted all of the subject matter from the definition of R<sup>4</sup> except hydrogen. These R<sup>3</sup> and R<sup>4</sup> amendments were an error based on a reversal of substituents; the preferred R<sup>3</sup> is hydrogen and the methyl group is the preferred R<sup>4</sup> group. The present amendment restores the definitions of R<sup>3</sup> and R<sup>4</sup> to

the definitions as they appear in the patent claim, except for the narrowing of carbon atom ranges in R<sup>4</sup> which find the same support in the original specification as discussed for claim 13. The present amendment removes the feature that the compound is of the formula (II) which appeared on line 2 of the claim as amended September 19, 2001.

Claim 16 (pending): The claim has been amended into independent form without further amendment.

Claim 17 (pending): The claim has been amended into independent form without further amendment.

Claim 18 (pending): The claim has been amended into independent form without further amendment.

Claim 19 (pending): The claim has been amended into independent form without further amendment.

Claim 20 (pending): The claim has been amended into independent form without further amendment.

Claim 21 (pending): The claim has been amended into independent form without further amendment.

Claim 22 (pending): The claim has been amended into independent form without further amendment.

Claim 23 (pending): The claim has been amended into independent form without further amendment.

Claim 24 (pending): The claim has been amended into independent form without further amendment.

Claim 25 (cancelled).

Claim 26 (cancelled).

Claim 27 (cancelled).

Claim 28 (pending): This method claim has been amended into independent form. The definition of the compounds is substantially the same as in claim 13, and the explanation of the earlier amendments and of the present amendments and the support therefor is the same as set forth hereinbefore for claim 13. The present amendment of claim 28 also deletes the feature that the compound is of the formula (II) which was added in the September 19, 2001 Amendment.

Claim 29 (pending): The definition of the compounds is substantially the same as in claim 14, and the explanation of the earlier and of the present amendments and the support therefor is the same as set forth hereinbefore for claims 14 and 28.

Claim 30 (cancelled).

Claim 31 (pending): This method claim has been amended into independent form without changing the scope of coverage. The definition of aralkyl group in the definition of  $R^4$  has been amended to correct the error pointed out by the Examiner in the second paragraph on page 1 of the Office Action.

Claim 32 (pending): The definition of the compounds is substantially the same as in claim 13, except that the definition of R is the same as in claim 31, and the explanation of the earlier and of the present amendments and the support therefor is the same as set forth hereinbefore for claim 13.

Claim 33 (pending): The definition of the compounds is substantially the same as in claim 14, and the explanation of the earlier and of the present amendments and the support therefor is the same as set forth hereinbefore for claim 14.

Claim 34 (cancelled).

Claim 35 (pending): This method claim has been amended into independent form without changing the scope of coverage. The definition of aralkyl group in the definition of  $R^4$  has been amended to correct the error pointed out by the Examiner in the second paragraph on page 1 of the Office Action.

Claim 36 (pending): The definition of the compounds is substantially the same as in claim 13 except that the definition of R is the same as in claim 35, and the explanation of the earlier and of the present amendments and the support therefor is the same as set forth hereinbefore for claim 13.

Claim 37 (pending): The definition of the compounds is substantially the same as in claim 14, and the explanation of the earlier and of the present amendments and the support therefor is the same as set forth hereinbefore for claim 14.

Claim 38 (cancelled).

Claim 39 (cancelled).

Claim 40 (pending): This method claim has been amended into independent form. The definition of the compounds is substantially the same as in claim 28, and the explanation of the earlier amendments and of the present amendments and the support

therefor is the same as set forth hereinbefore for claim 28. The present amendment of claim 40 also deletes the feature that the compound is of the formula (II) which was added in the September 19, 2001 Amendment.

Claim 41 (pending): The definition of the compounds is substantially the same as in claim 29, and the explanation of the earlier and of the present amendments and the support therefor is the same as set forth hereinbefore for claim 29.

Claim 42 (cancelled).

Claim 43 (pending): Original claim 43 depended from claim 8 which defines the  $R^2$  group. The present amendment changes the dependency and inserts the reference to  $R^2$ . The amendment to the number of substituent groups is supported by column 7, line 17.

Claims 44-52 (pending)(new): Claims 44-52 replace cancelled claim 30. Claim 44 is directed to the first named compound in claim 30. Claim 45 is directed to the second named compound. Claim 46 is directed to the third named compound. Claim 47 is directed to the fourth named compound. Claim 48 is directed to the fifth named compound. Claim 49 is directed to the sixth named compound. Claim 50 is directed to the seventh named compound. Claim 51 is directed to the eighth named compound.

Claim 52 is directed to the ninth named compound. The tenth and eleventh named compounds in patent claim 30 were deleted in reissue application claim 30. Claims 44-52 are supported by the disclosure of each of the named compounds in cancelled claim 30 and in columns 26, 27 and/or 28.

Claims 53-61 (pending)(new): Claims 53-61 replace Markush claim 34. The relationship of the respective claims 53-61 to claim 34 and support in the patent for each of these claims is the same as set forth for claims 44-52 except for the different dependency.

Claims 62-70 (pending)(new): Claims 62-70 replace Markush claim 38. The relationship of the respective claims 62-70 to claim 38 and support in the patent for each of these claims is the same as set forth for claims 44-52 except for the different dependency.

Claims 71-79 (pending)(new): These claims replace Markush claim 42. The relationship of the respective claims 71-79 to claim 42 and support in the patent for each of these claims is the same as set forth for claims 44-52 except for the different dependency.

Claim 80 (pending) (new): The compounds wherein  $R^3$  is hydrogen and  $R^4$  are preferred compounds. Each of the compounds identified in the species claims (each of claims 16-26) is a compound in which  $R^3$  is hydrogen and  $R^4$  is methyl. These compounds are described as "more preferred compounds" in column 26, lines 42-44.

Claim 81 (pending) (new): The feature of this claim, namely that the compounds of the formula (II) is specific to one of the two classes of structural compounds which together encompass all of the claimed subject matter. Applicants are entitled to claim each portion of the originally disclosed subject matter separately with the original broad disclosure providing the necessary support. Additionally, nine of the eleven species which are the subject of original claims (claims 16-26), is a compound of the formula (II).

Claim 82 (pending) (new): The explanation concerning support for claims 80 and 81 applies to claim 82. Presently, nine compounds are the subject of species claims (first referring to claims 16-24). Eight of these nine compounds meet the requirement of claim 82.

Claim 83 (pending) (new): The explanation concerning support for claims 80 and 81 applies to claim 83. Presently, nine compounds are the subject of species claims (first referring to



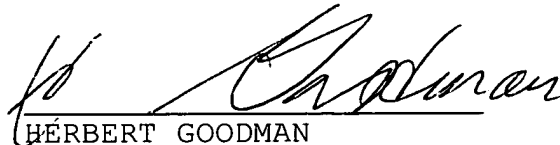
claims 16-24). Eight of these nine compounds meet the requirement of claim 83.

Claim 84 (pending) (new): The explanation concerning support for claims 80 and 81 applies to claim 84. Presently, nine compounds are the subject of species claims (first referring to claims 16-24). Eight of these nine compounds meet the requirement of claim 84.

Claim 85 (pending) (new): The explanation concerning support for claims 80 and 81 applies to claim 85. Presently, nine compounds are the subject of species claims (first referring to claims 16-24). Eight of these nine compounds meet the requirement of claim 85.

Claim 86 (pending) (new): The explanation concerning support for claims 80 and 81 applies to claim 86. Presently, nine compounds are the subject of species claims (first referring to claims 16-24). Eight of these nine compounds meet the requirement of claim 86.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "H. Goodman", is written over a horizontal line.

HERBERT GOODMAN  
Reg. No. 17,081

Date: February 27, 2002